REMARKS

Presently, claims 1, 3, 5 – 8, 10 – 18, 22 – 23 and 25 are pending in the application. No new subject matter has been added.

Claim Rejection – § 103(a)

The Examiner has rejected claims 1, 3, 5 – 20, 22 – 23 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,661,516 to Carles ("Carles"), in view of U.S. Patent No. 5,652,615 to Bryant ("Bryant"), in further view of U.S. Patent Application Publication No. 2006/0041921 to Hane ("Hane"), U.S. Patent No. 6,487,721 to Safadi ("Safadi") and U.S. Patent No. 5,754,787 to Dedrick ("Dedrick"). Applicants respectfully traverse this rejection.

As an initial matter, Applicants note that claims 9 and 19 have been previously cancelled. Thus, the Examiner's rejection of these claims is moot.

Carles teaches a method of providing advertisements to individual subscribers by tagging commercials with routing information and converter addresses. Carles uses a database of "smart" commercials containing embedded information identifying the categories of recipients for the message. The commercials are inserted into the data stream based on a previously created schedule.

Bryant teaches architecture for transmitting programming to customers. In Bryant, "base" and "fill" segments are transmitted concurrently to the customer. The number of fill segments transmitted in one signal is selected based on the bandwidth of the signal. Thus, four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal. Column 5, lines 4-9.

Hane teaches an "electronic exchange for the purchase, sale, and/or trading of advertising or other electronic delivery obligations." Paragraph 25. Hane's system allows, "authorized users to…post for sale advertising avails or other inventory that permits the delivery of programming or other data, and allows authorized users to bid for and to

purchase certain delivery commitments." Id. In making a media buy, the advertiser in Hane may specify necessary parameters such as time frame, markets, length of advertisement and preemptability. Paragraph 52. However, in Hane it is the advertiser administrator that may "establish levels of access and set priorities for the use of available bandwidth and other inventory."

Safadi teaches inserting pre-stored advertisements that were not compressed or only partially compressed, and "enables rate adaptation such that the commercial content fits the bandwidth allocated for the program to which the commercial belongs." Column 5, lines 27-34. In Safadi, a cue command, "includes descriptive parameters pertaining to the program attributes that the commercial must match." Rate is one such parameter included in the cue command. Column 6, lines 38-41. However, Safadi only speaks to the cue command issued by the advertiser, which describes the rate of the advertisement slot – not the requirements of the advertiser for actual insertion of the advertisement.

Dedrick teaches that an advertiser of electronic information may label the content which they create with bandwidth requirements and cost parameters. Column 13, lines 13-16. At the authoring site, the advertiser inserts the desired minimum and maximum bandwidth and the amount the advertiser is willing to pay for those transport mechanisms. A smart router looks at the labels associated with each of the multimedia pieces of content as designated through the requirement and cost parameters of the header block of the electronic information, and determines which link should be used to deliver the content. See Column 13, lines 40-46. Thus, the minimum bandwidth requirements are used to select an appropriate delivery mechanism for the content that has already been selected for delivery to the user.

1. **The combination of Carles, Bryant, Hane, Safadi and Dedrick does not teach or suggest each and every element of claim 1.**

The combination of Carles, Bryant, Hane, Safadi and Dedrick does not teach or suggest, "wherein the minimum bandwidth requirements identify a required amount of bandwidth available within the program stream **for the advertisement to be inserted**,"

as recited in independent claim 1. The Examiner admits that Carles, Bryant, Hane and Safadi do not teach this feature of claim 1, relying on Dedrick. However, in Dedrick the minimum bandwidth requirements do not **determine whether the advertisement will be inserted.** Instead, in Dedrick once an advertisement is selected, a delivery link is selected that best matches the bandwidth requirements for that particular advertisement. Thus, Dedrick first selects the content and then "determines which electronic information needs to be delivered at what quality and at what cost." Column 13, 33-39. Once this determination is made, "if there are multiple links available, the smart router takes advantage of the link which best matches the associated label that the author inserted in the header block of the electronic information. Column 13, lines 40-45. However, where there is only one available link, that link is used to transport the electronic information. Column 13, lines 45-46. Thus, in Dedrick an advertisement will be delivered regardless of the minimum bandwidth requirements; Dedrick merely teaches analyzing the available delivery links to identify the link that best matches those requirements. In contrast, in claim 1, an advertisement is selected for delivery only if the bandwidth requirements may be satisfied. There is no such teaching in Dedrick.

The combination of Carles, Bryant, Hane, Safadi and Dedrick also does not teach or suggest, "compressing, based at least in part on the avail bandwidth, the selected targeted advertisement such that the minimum bandwidth requirements are satisfied," as recited in independent claim 1. The Examiner relies on Safadi for this teaching, contending that, "the commercial may be compressed as to enable rate adaptation such that the commercial content fits the bandwidth allocated for the program to which the commercial belongs." Office Action, page 7. Applicants respectfully disagree with the Examiner's reading of Safadi, in that Safadi merely selects pre-stored advertisements matching the rate of the insertion opportunity, but does not compress the selected advertisement such that minimum bandwidth requirements are satisfied. Furthermore, even applying the Examiner's incorrect interpretation of Safadi, the "compressing" in Safadi results in matching the advertisement bandwidth to the bandwidth allocated for the ***program*** into which the advertisement will be inserted. In contrast, in claim 1, the advertisement is compressed such that the **minimum bandwidth requirements *of the***

advertisement or advertiser **are satisfied.** Thus, Safadi does not teach or suggest compressing the advertisement such that the advertiser's minimum bandwidth requirements are satisfied.

In view of the foregoing, Applicants respectfully submit that the proposed combination – even if proper – does not teach or suggest all features of independent claim 1. Independent claims 22 and 25 recite features similar to those of independent claim 1, and the proposed combination does not teach or suggest all elements of these claims for similar reasons as discussed for independent claim 1.

2. The combination of Carles, Bryant, Hane, Safadi and Dedrick is inoperable.

The proposed combination of Carles, Bryant, Hane, Safadi and Dedrick is inoperable. MPEP § 2143.01(V) states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" (emphasis added). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)" (emphasis added).

Carles teaches inserting advertisements based on a previously created schedule. Bryant teaches that the number of fill segments transmitted in one signal are selected based on the bandwidth of the signal (e.g., four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal). Hane teaches an electronic exchange for the sale advertising avails. Safadi teaches compressing and inserting advertisements that have been pre-stored at subscriber equipment. Dedrick teaches selecting an appropriate delivery link for content based on specified minimum bandwidth requirements. Because Bryant attempts to group advertisements in a manner to take advantage of available bandwidth and Hane teaches an electronic exchange for avail sales, the pre-ordained advertisement schedule of Carles would be irrelevant and/or

inoperable when combined with the real time systems of Bryant and Hane. That is, Bryant and Hane would require alterations to the Carles' previously created, predefined schedule at every insertion opportunity, thereby defeating the stated purpose of an advertisement schedule in the first place. As such, the proposed combination is improper since any modification of Carles' teachings by Bryant and/or Hane would effectively change the principle of operation of Carles' system.

In view of the impropriety of combining Carles, Bryant, Hane, Safadi and Dedrick, and the fact that such combination would not teach or suggest all features of the claimed subject matter, Applicants respectfully submit that one skilled in the art would not have found it obvious to result in Applicants' claims. Accordingly, independent claims 1, 22 and 25 are allowable at least for the reasons discussed above. Dependent claims 3, 5-8, 10-18 and 23 are allowable based, at least in part, on their dependency on independent claims 1 and 22, respectively. Accordingly, Applicants submit that the Examiner's rejection under 35 U.S.C. §103 has been overcome, and respectfully request that such rejection be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-3, 5-8, 10-18, 22-23 and 25, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 3/24/11 By: _____

Andrew W. Spicer
Registration No. 57,420
Carlineo, Spicer & Kee, LLC
2003 South Easton Road, Suite 208
Doylestown, PA 18901
267-880-1720
Customer No.: 81712